

Attorney's Docket:2004DE303
Serial No.: 10/591,573
Group:1792

REMARKS

The Office Action mailed August 7, 2008 has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the Application as originally filed. No new matter has been added. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

CLAIM STATUS

Claims 1-20 are pending in this Application. By this Amendment, claims 1-7, 10-15, 20, 22, 23, 25-26 have been amended. Claim 21 has been cancelled.

Claim Rejections Under 35 USC § 112, Second Paragraph

Claims 1-28 stand rejected under 35 USC § 112, second paragraph, as being indefinite. With respect to claims 1-6, 12-15, 20-22 the Office states, "articles claims calling for "coating for (structure)" are improper in form." By this Amendment, the subject claims have been amended with the preamble reading as follows "A coating composition for coating a surface."

The Office finds that in claims 1 and 20 the phrase "when cured" is indefinite "and that a curing step is not claimed, and therefore the coating may or may not cured."

The subject claims have been amended to recite the phrase "wherein the coating composition is cured to the surface . . ." It is believed that this amendment makes clear that the coating composition is cured to the surface.

The Office has directed Applicants to an inadvertent error of the omission of the word "claim." Such word has been inserted into claim 10.

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Claim Rejections Under 35 USC § 112, First Paragraph

Claims 2, 3 and 12-15 stand rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. The Office states as follows:

The following is not in the specification as filed, and therefore enabled:

Claim 2 at least 1% not more than 100%.

Claim 3 as above

Claims 12-15 the mass fraction ranges

Applicants respectfully contend that the rejection under 35 USC § 112, first paragraph is improper. The originally filed claims contain each of the limitations objected to in claims 2, 3 and 12-15. As the originally filed claims constitute a part of the specification it is respectfully contended that the subject phrases are enabled, especially, given the fact that they are either weight percentages or mass fraction ranges which are well within the purview of one with ordinary skill in the art. For at least this reason, it is respectfully contended that the 35 USC § 112, first paragraph rejection has been traversed.

Claim Objection

Claim 21 stands objected to under 35 CFR § 1.75(c) as being of improper dependent form. The Office states that claim 21 does not further limit claim 20. By this Amendment, claim 21 has been cancelled.

Claim Rejections Under 35 USC § 103

Claims 1-17 and 19-28 stand rejected under 35 USC § 103(a) as being unpatentable over Suzuki (US 2003/0164113). Claims 1-9, 11-15 and 17-23 stand rejected under 35 USC § 103(a) as being unpatentable over EP 899091. This rejection is respectfully traversed.

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Independent claims 1 and 20 have been amended to make mandatory the presence of one or more cobinders. It is respectfully contended that neither Suzuki (US 2003/0164113) nor EP 899091 teach, disclose or suggest the claimed compositions wherein one or more cobinders are present. For at least this reason it is Applicants' courteous position that claims 1-17 and 19-28 are not made obvious by Suzuki (US 2003/0164113) nor EP 899091. Applicants therefore, courteously solicit reconsideration and withdrawal of the rejection.

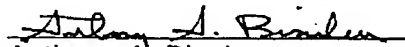
Double Patenting

Claims 1-20 are provisionally rejected on the ground of non-statutory obviousness type double patenting as being unpatentable over claims 1-3 of co-pending Application Nos. 11/667654; 11/791,550; 11/884,856; 11/991,718 and 12/084,191.

As Applicants have amended the independent claims to recite the presence of one or more cobinders, it is believed that the present claims are not obvious over any one of the above referenced co-pending Applications.

In view of the forgoing amendments and remarks, the present Application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, she is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,


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